

The Office Action rejects claims 1-5, 8, 10-12, 14, 15, 27-38 and 43-47 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,173,627 to Madrange née Dermain et al. (hereinafter "Madrange"). Applicants respectfully disagree with this rejection.

Madrange discloses a pressurized container containing a hair lacquer composition partially in the gaseous phase and partially in the liquid phase. This composition comprises at least one resin suitable for use as a hair lacquer, a liquid capable of dissolving the resin, and a propellant comprising bromotrifluoromethane (col. 2, lines 11-21). Madrange further discloses that the liquid phase contains at least one of (a) a lower alkanol such as ethanol, propanol, isopropanol or butanol; (b) a solvent such as 1,1,1 trichloroethane and methylene chloride; and (c) a diluent such as a ketone, particularly acetone or methyl ethyl ketone, an alkyl acetate such as methyl acetate or ethyl acetate, or a hydrocarbon such as a C<sub>3</sub>-C<sub>7</sub> alkane (col. 3, lines 37-47).

Claims 1-5, 8, 10-12, 14-15, and 27-38 of the present invention are directed to, *inter alia*, compositions comprising both (1) ethanol and (2) methyl acetate and/or t-butyl acetate. Although Madrange does disclose the use of ethanol or methyl acetate individually, it does not disclose a hair care composition comprising both ethanol and methyl acetate in combination. Furthermore, Madrange is silent with respect to the use of t-butyl acetate. Thus, Madrange does not anticipate claims 1-5, 8, 10-12, 14-15, and 27-38 of the present invention and, as such, Applicants respectfully request that this rejection be withdrawn.

With respect to the rejection of claims 43-47, these claims are directed to a consumer article comprising, *inter alia*, a sprayable composition comprising (1) isopropanol and (2) methyl acetate and/or t-butyl acetate. As stated above, Madrange does disclose the use of methyl acetate individually. Madrange also discloses a composition comprising isopropanol. However, Madrange does not disclose a composition with both isopropanol and methyl acetate in combination. Moreover, as stated above, Madrange is also silent with respect to the use of t-

butyl acetate. Thus, Madrange does not disclose every element of the claimed invention and, as such, does not anticipate claims 43-47 of the present invention. Therefore, Applicants respectfully request that this rejection be withdrawn.

B. Rejection of claims 1-2, 8-10, 16-17, 31-35, 37, 39-44 and 46 over U.S. Patent No. 4,243,548

The Office Action further rejects claims 1-2, 8-10, 16-17, 31-35, 37, 39-44 and 46 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,243,548 to Heeb et al. (hereinafter "Heeb"). Applicants respectfully disagree with this rejection.

Heeb discloses a pressurized aerosol formulation comprising a propellant gas, organic solvents, and an active compound. It is further disclosed that suitable organic solvents for use in the formulation include acetone, ethyl methyl ketone, diethyl ether, dimethoxymethane, diethyl carbonate, ethyl alcohol, n-propanol, isopropanol, methyl acetate, ethyl acetate, methoxyacetone, hydroxyacetone, methyl isopropyl ketone, diethyl ketone, diisopropyl ketone, dipropyl ketone, diacetone alcohol, dichloroethane, 1-chlorobutane and mixtures thereof (col. 2, lines 35-60).

Claims 1-2, 8-10, 16-17, 31-35, 37, and 39-42 of the present invention are directed to, *inter alia*, compositions comprising both (1) ethanol and (2) methyl acetate and/or t-butyl acetate. Although Heeb similarly discloses the use of ethanol or methyl acetate individually, it does not disclose a composition comprising both ethanol and methyl acetate in combination. Furthermore, like Madrange, the disclosure of Heeb is silent with respect to the use of t-butyl acetate. Therefore, Heeb does not disclose every element of the claimed invention and, as such, claims 1-2, 8-10, 16-17, 31-35, 37, and 39-42 of the present invention are novel over Heeb. Thus, Applicants respectfully request this rejection be withdrawn.

With respect to the rejection of claims 43, 44 and 46, as previously discussed herein,

these claims are directed to a consumer article comprising, *inter alia*, a sprayable composition comprising (1) isopropanol and (2) methyl acetate and/or t-butyl acetate. Although Heeb does disclose the use of isopropanol individually, it similarly fails to disclose a composition with both isopropanol and methyl acetate in combination. Furthermore, as previously discussed herein, Heeb is silent with respect to t-butyl acetate. Thus, Heeb fails to disclose every element of the claimed invention and, as such, does not anticipate claims 43-47. Therefore, Applicants respectfully request that this rejection be withdrawn.

**II. Claim Rejections under 35 U.S.C. 103(a)**

**A. Rejection of claims 1-40 and 43-48 in view of "Madrang"**

The Office Action has rejected claims 1-40 and 43-48 under 35 U.S.C. § 103(a) as allegedly being obvious in view of Madrange. Specifically, the Office Action contends that it would have been obvious for one of ordinary skill in the art to modify the disclosure of Madrange in order to arrive at the claimed invention. Applicants respectfully disagree with this rejection.

It is well established that in order to establish a *prima facie* case of obviousness, the prior art must teach, or at least suggest, the claimed invention as a whole. Moreover, there must be adequate motivation and an expectation of success to undertake the modification proposed in the rejection. Here, neither standard is met.

Claims 1-40 and 48 of the present invention recite, *inter alia*, a composition comprising ethanol in combination with methyl acetate and/or t-butyl acetate. Claims 43-47 of the present invention similarly recite, *inter alia*, a composition comprising isopropanol in combination with methyl acetate and/or t-butyl acetate.

First, as previously set forth in detail, Madrange is silent with respect to t-butyl acetate and, as such, there is no motivation or suggestion to include t-butyl acetate in the hair lacquer compositions of Madrange. Additionally, although Madrange does disclose compositions containing ethanol, isopropanol and methyl acetate individually, it does not teach or suggest a composition comprising the combinations of (1) ethanol or isopropanol and (2) methyl acetate and/or t-butyl acetate as claimed in the present invention. In fact, none of the examples in Madrange disclose an alkyl acetate, much less the use of methyl acetate or t-butyl acetate, in combination with an alcohol. In contrast, Madrange actually teaches away from Applicants' inventive combinations as it discloses that both alkanols and alkyl acetates are not required components of the disclosed hair lacquer compositions (col. 3, lines 48-52). Thus, there is no motivation in Madrange to use the specific combination of features of the claimed invention. As such, the Office Action has failed to present a *prima facie* case of obviousness.

Irrespective of the Office Action's failure to present a *prima facie* case of obviousness, the inventive combinations of (1) ethanol or isopropanol and (2) methyl acetate and/or t-butyl acetate for use in a hair care composition would not have been obvious to one of ordinary skill in the art in light of Applicants' substantially superior and unexpected results. Specifically, Applicants have unexpectedly discovered that the cosmetically unacceptable odor associated with alkyl acetates, such as methyl acetate or t-butyl acetate, is substantially reduced when combined with an alcohol such as ethanol or isopropanol. Moreover, as compared to alcohol formulations, the compositions of the instant invention have a lower VOC, which is more environmentally acceptable. Thus, alkyl acetates can replace some of the alcohol currently present in many consumer spray formulations without lessening consumer acceptance (see specification at page 3, lines 16-29). Therefore, as it is desired for hair care compositions to preferably retain a pleasant odor, one of ordinary skill in the art would not have been motivated to combine methyl acetate or t-butyl acetate with an alcohol as claimed in the present invention.

Consequently, claims 1-40 and 43-48 of the present invention are not obvious over Madrange and, as such, Applicants' respectfully request that this rejection under 35 U.S.C. § 103(a) be withdrawn.

B. Rejection of claims 1-2, 8-10, 16-17, 31-35, 37, 39-44 and 46  
in view of Heeb

The Office Action has rejected claims 1-2, 8-10, 16-17, 31-35, 37, 39-44 and 46 under 35 U.S.C. § 103(a) as allegedly being obvious in view of Heeb. The Office Action contends that it would have been obvious for one of ordinary skill in the art to modify the disclosure of Heeb in order to arrive at the claimed invention. Applicants respectfully disagree with this rejection.

Claims 1-2, 8-10, 16-17, 31-35, 37 and 39-42 of the present invention recite, *inter alia*, a composition comprising ethanol in combination with methyl acetate and/or t-butyl acetate. Similarly, claims 43, 44 and 46 of the present invention recite, *inter alia*, a composition comprising isopropanol in combination with methyl acetate and/or t-butyl acetate. As previously discussed herein, Heeb is silent with respect to t-butyl acetate and, as such, there is no motivation or suggestion to include t-butyl acetate in the aerosol formulations of Heeb. Additionally, although Heeb similarly discloses compositions containing ethanol, isopropanol, or methyl acetate individually, it likewise does not teach or suggest a composition comprising the specific combination of (1) ethanol or isopropanol and (2) methyl acetate and/or t-butyl acetate as claimed in the present invention. In fact, all of the examples set forth in Heeb, except for example 16, fail to disclose the use of an alkyl acetate, much less the use of methyl acetate or t-butyl acetate, in combination with an alcohol. Furthermore, although example 16 does disclose methyl acetate, example 16 is not directed to a hair care composition but, rather, a room spray formulation. Moreover, it further discloses that methyl acetate is only to be used in combination with 1,1,1 trichloroethane as opposed to an alcohol (Col. 8, lines 34-35). Thus, there is no

motivation in Heeb to use the specific combination of features of the claimed invention and, as such, the Office Action has again failed to present a *prima facie* case of obviousness.

Irrespective of the Office Action's failure to present a *prima facie* case of obviousness, the inventive combination of (1) ethanol or isopropanol and (2) methyl acetate and/or t-butyl acetate for use in a hair care composition would not have been obvious to one of ordinary skill in the art in light of Applicants' substantially superior and unexpected results. As previously set forth above, Applicants have unexpectedly discovered that the cosmetically unacceptable odor associated with alkyl acetates, such as methyl acetate or t-butyl acetate, is substantially reduced when combined with an alcohol such as ethanol or isopropanol. Moreover, as compared to alcohol formulations, the compositions of the instant invention have a lower VOC, which is more environmentally acceptable. Thus, alkyl acetates can effectively replace some of the alcohol currently present in many consumer spray formulations without lessening consumer acceptance (see specification at page 3, lines 16-29). Therefore, because it is desired for hair care compositions to preferably retain a pleasant odor, one of ordinary skill in the art would not have been motivated to combine methyl acetate or t-butyl acetate with an alcohol as claimed in the present invention.

Thus, one of ordinary skill in the art would not be motivated to modify the aerosol formulations of Heeb to include the inventive combinations of the present invention. As such, Applicants' respectfully request that this rejection under 35 U.S.C. § 103(a) be withdrawn.

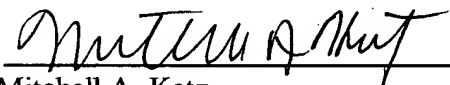
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**CONCLUSION**

In view of the Remarks set out above, it is respectfully asserted that the rejections set out in the August 21, 2000 Office Action have been overcome and that the application is in condition for allowance. Therefore, Applicants respectfully seek notification of the same.

Respectfully submitted,

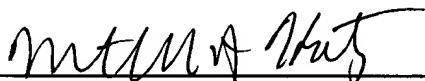
NEEDLE & ROSENBERG, P.C.

  
\_\_\_\_\_  
Mitchell A. Katz  
Registration No. 33,919

NEEDLE & ROSENBERG, P.C.  
Suite 1200, The Candler Building  
127 Peachtree Street, N.E.  
Atlanta, Georgia 30303-1811  
(404) 688-0770

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Mitchell A. Katz

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